

REMARKS/ARGUMENTS

Claims 1-16, 18 and 25-32 are pending. Claims 16 and 31 are amended by the present amendment and Claim 33 is canceled.

The present amendment adds the subject matter of Claim 33 (which previously depended from Claim 16) to Claim 16. Accordingly, Claim 33 is also canceled. Further, Claim 31 is amended only to avoid redundancy with respect to the feature added to Claim 16 (that the adhesive sheet is in contact with the make-up product at the second opening). Further, in view of the amendment to Claim 16 to recite the feature of the adhesive sheet being in contact with the make-up product, the prior recitation in Claim 16 of the adhesive sheet "facing" is deleted as superfluous in view of the more detailed recitation incorporated from Claim 33.

Because the amendment only adds a feature previously set forth in a dependent claim to Claim 16, it is submitted that no new issues are raised. Accordingly, it is submitted that entry of the present amendment is proper, because the amendment either places the application in condition for allowance as discussed in further detail below, or at a minimum, places the application in better form for appeal should the Examiner deem the present application is not in condition for allowance.

The Office Action rejected Claims 1-6, 8, 9, and 11-14 as obvious in view of Kelly and Coburn. Claims 10 and 15 were rejected as obvious in view of the foregoing references, and further in view of Guiard (WO 97/15910). Claims 7, 16, 18 and 33 were rejected as obvious in view of Kelly and Guiard. Finally, Claims 29-32 were rejected as obvious in view of Kelly, Guiard and Coburn. For the reasons set forth in detail below, it is respectfully submitted that this application is now in condition for allowance.

Respectfully, it is submitted that the Office Action presents two inconsistent positions with respect to the rejection of Claim 1, and it is submitted that neither position establishes

the present invention is disclosed or rendered obvious by the cited references. Specifically, in the rejection of Claim 1 based on Kelly and Coburn, the Office Action acknowledges (at page 3) that Kelly does not disclose the sticker forming a mirror, and therefore, the Office Action asserts that it would have been obvious to have modified Kelly in view of the teachings of Coburn to provide the claimed mirror. However, the Office Action then asserts (at page 7) that Kelly is considered to disclose a metallic foil which the Examiner considered to be a mirror – apparently asserting that Coburn is not relied upon for a mirror, but instead that a mirror is inherent in Kelly. It is respectfully submitted that neither of the positions asserted in the Office Action establish that the cited references anticipate or render obvious the present invention.

Considering Kelly alone, it is submitted that the disclosure of a metallic material does not inherently mean that the material is a mirror as the Office Action (at p. 7) asserts.

As set forth in MPEP 2112 (emphasis added): “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may *not* be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (quoting *In re Robertson*, 169 F.3d743, 745 (Fed. Cir. 1999)).

A metallic material is clearly not inherently a mirror as numerous metallic materials do not inherently provide a mirror. Moreover, considering the entirety of the Kelly disclosure, it is clear the reference to a metallic material does not provide a disclosure as to the use of a mirror, because when Kelly desires to specify a mirror, Kelly plainly states that a mirror is provided – at element 22.

Although the Office Action (at page 7) states that Kelly discloses the use of a metallic foil, at paragraph 0021 Kelly merely discloses the use of a metallic material as an alternative

to a cardboard material for the hinge 24. The specification of a metallic material or even a foil alternative is clearly not a disclosure that a mirror is provided. Further, the Examiner's assertion that it is well known that metallic foils can act as a mirror is insufficient, the Examiner has provided no evidence to establish that one skilled in the art would have modified Kelly to provide a mirror with the hinge 24. The teachings of Kelly are to the contrary, a cardboard material is preferred (clearly not a mirror), and a metal material is merely mentioned among a list of alternatives – with no mention at all that the metal material or any other alternative forms a mirror.

Kelly in fact discloses a mirror 22 in the lid of the device. Paragraph 0019 and Fig. 1 of Kelly. The apparent assertion of the Office Action that Kelly's metal material alternative (listed among many other alternatives to a cardboard hinge, including a cellulose based material or polymeric material) inherently would be a mirror is incorrect. Kelly already provides a mirror at 22. The specific disclosure of a mirror in the lid further demonstrates that the general disclosure of a metallic material as alternative material for the hinge clearly does not provide a disclosure as to the use of a mirror associated with a hinge.

None of the cited references discloses or suggests the combined features set forth in Claim 1 in which a support and a lid are articulated to each other by a sticker which forms a mirror.

The combination of Kelly with Coburn also fails to render obvious the combined features set forth in Claim 1. Specifically, Coburn merely teaches the use of a metalized surface 30 which provides a reflecting surface of a mirror as shown at 12 in Fig. 1 (col. 2, line 64). At best, if one were to modify the teachings of Kelly in view of the teachings of Coburn, one would simply substitute the mirror 22 in the lid of Kelly with a mirror formed with a surface as disclosed by Coburn. However, there is nothing whatsoever to suggest to provide

a sticker which both provides an articulation between a support and a lid, and which forms a mirror.

In view of the forgoing, it is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose or render obvious the combined feature set forth in Claim 1.

The only other pending independent claim, Claim 16, is also in condition for allowance. Claim 16 recites the feature in which a lid and support are articulated to each other by an arrangement which includes an adhesive sheet, and that the adhesive sheet also covers the opening extending through the support, with the adhesive sheet directly contacting the make-up product in the cavity of the support. None of the cited references discloses or suggests an arrangement as set forth in Claim 16, in which an adhesive sheet provides both an articulation between a lid and a support and also which closes off an opening in a support such that the adhesive sheet contacts the product as set forth in Claim 16.

The Office Action acknowledges that Kelly does not even disclose an arrangement in which a cavity is provided having first and second openings. To overcome such deficiencies, the Office Action relies upon the teachings of Guiard. However, Guiard merely discloses providing a cover to close an opening. There is no disclosure or suggestion in the references, considered individually or collectively, as to the provision of an adhesive sheet which both provides an articulation between a lid and a support, and which covers an opening of a make-up product containing cavity of a support with the adhesive sheet in contact with the product. Accordingly, it is submitted that even considering the combined teachings of the cited references, the invention set forth in Claim 16 would not result.

The cited references also fail to disclose or suggest numerous features set forth in the present dependent claims. For example, the Office Action does not even address Claims 25-28 on their merits, instead asserting that these claims are directed to a non-elected invention.

However, the election/restriction is respectfully traversed. Claims 25-28 depend, directly or indirectly, from Claim 1, and thus, Claim 1 is not directed to a different invention than Claims 25-28. Claims 25-28 simply recite additional features that can also be present in combination with the features of Claim 1. Claims 25-28 are allowable for at least the same reasons as the claims from which they depend, and moreover, Claims 25-28 recite additional patentable features.

With regard to dependent Claim 10, the Office Action asserts that Claim 10 is obvious in view of the combined teachings of Kelly, Coburn and Guiard. However, Guiard provides a cover because there is no lid, and it is only Applicant's own disclosure which suggests the combined features of Claim 10 in combination with features of Claim 1 (from which Claim 10 depends). The Office Action also fails to establish how, absent Applicant's own disclosure, one skilled in the art would provide an arrangement as set forth in Claims 29 and 30 arranged as set forth in the claims. The Office Action appears to merely reconstruct the claimed invention by selectively picking and choosing elements from the various references and arranging them as set forth in the claims, based only upon the subject matter set forth in the claims and absent any teachings to arrange elements as only described in the present specification.

In addition to the forgoing, the Office Action asserts that the dimensions of the 0.5mm-2mm are a matter of "optimal or workable ranges" and asserts such feature would have been obvious, without the citation of any evidence in support. This rejection is traversed in that: (1) the Office Action fails to establish how the dimensions are a mere matter of optimal or workable ranges; (2) particularly with regard to this feature, the Office Action improperly considers features in isolation rather than considering the claimed subject matter as a whole (including not only the subject matter of dependent Claims 11, 12, 28 and 32, but also the claims from which they depend). In this regard, Applicant has recognized

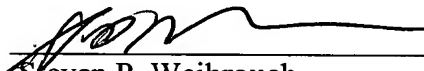
that the present invention is particularly advantageous for a small-sized product, for example, one that can be provided as a sample, because the present invention is particularly advantageous in the context of a small-sized sample-like device that must be efficiently formed with a compact size. The cited references also fail to disclose or suggest the features set forth in dependent Claims 11, 12, 28 and 32 – particularly in combination with the features of the claims from which they depend.

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance. A Notice of Allowance for claims 1-16, 18, and 25-32 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, he or she is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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